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Paper No. 5

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OFFICE OF PETITIONS

In re Reissue Application for Patent No. 6,024,708 :
Original Patent Issued: February 15, 2000 :
Reissue Application No. 10/074,012 :
Filed: February 14, 2002 :
Attorney Docket No. 06530.0290 :

ON PETITION

This decision concerns the July 3, 2002 petition under 37 CFR 1.47(a).¹

The petition is DISMISSED.

The instant application is a reissue application for Patent No. 6,024,708 ('708 Patent). Three inventors are named in this application: Thomas O. Bales ("Bales"), Charles R. Slater ("Slater"), and Kevin W. Smith ("Smith"). The "Reissue Declaration under 37 CFR 1.175" filed with the application on February 14, 2003 ("2/14/03 Declaration") was signed only by Bales. The instant petition is filed in response to a May 6, 2002 "Notice to File Missing Parts of Reissue Application" which set forth an extendable 2-month reply period.

The petition asserts that Slater and Smith "cannot be reached after diligent effort,"² and requests that Bales be allowed to file the reissue application on behalf of himself and the 2 remaining inventors. The facts presented in the petition indicate that Slater and Smith had been located at their common work address by mail, telephone and e-mail, but did not respond as of the filing of the instant petition. The petition in essence is alleging that Slater and Smith refuse to join in this application.

Under 37 CFR 1.47(a), Bales may file this application on behalf of himself as well as Slater and Smith, provided that a *bona fide* attempt has been made to present to each of them, for review and signature, a copy of the *entire* reissue application (i.e., a copy of the '708 Patent: specification including claims, and drawings; as well as the February 14, 2003 Preliminary Amendment), but the latter refuse to join in this application.³

To show that Slater and Smith refuse to join in this application despite such a *bona fide* attempt, the petition must include, *inter alia*, a statement of facts concerning not only the circumstances of the presentation of the application papers to each of them at their respective last known

¹ The petition was recently forwarded to the Office. The Office sincerely apologizes for any inconvenience caused by the delay.

² Petition, page 1, 2nd paragraph, 3rd line.

³ 37 CFR 1.47(a); MPEP section 409.03(e) (Rev. 1, Feb. 2003).

addresses,⁴ but also the subsequent refusal by each of them.⁵

The instant petition contains a "Declaration in Support of Petition under 37 CFR 1.47(a)" by a Kathleen Cronin, an employee of the parent corporation for Assignee ("Cronin") ("Cronin Declaration"). According to the Cronin Declaration and the accompanying exhibits, Cronin mailed a copy of the **draft preliminary amendment**⁶ to Slater and Smith, on February 7, 2002, at their last known work address. There is no indication that a copy of the '708 Patent (specification including claims; drawings) was provided to Slater and Smith prior to, with, or after, the February 7, 2002 mailing.

The Office notes that a reissue declaration, unlike that in the original patent application, must state, *inter alia*, that **all errors** being corrected in the reissue application up to the time of filing the reissue declaration **arose without any deceptive intention on the part of the applicant**.⁷ Since the assignment that transferred the entire rights in the instant invention from the inventors to Assignee was executed in 1992, and the '708 Patent was issued to Assignee 10 years later, it is not likely that the inventors are familiar with the contents of that patent when issued.

Moreover, the 2/14/03 Declaration contains the following paragraphs: "[w]e believe we are the original, first, and joint inventors of the subject matter claimed in [the '708 Patent] . . .";⁸ "[w]e believe that [the '708 Patent] is partially inoperative because we claimed less than we had a right to claim in that patent . . . we . . . request . . . to broaden the scope of . . . the ['708 Patent];⁹ and "[a]ll errors being corrected in the reissue application up to the filing of the present Declaration arose without deceptive intention on our part."¹⁰ Even if assuming, *arguendo*, that Slater and Smith are in receipt of the draft preliminary amendment mailed by Cronin on February 7, 2002, the 2/14/03 Declaration is nevertheless defective. This is because Slater and Smith, if not cognizant of the claimed invention in the '708 Patent, will be, likewise, unaware of the asserted "errors" of narrower scope than entitled, and certainly cannot be in a position to compare the 2

⁴ *Id.*

⁵ See MPEP section 409.03(d) (Rev. 1, Feb. 2003) (Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . . When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.).

⁶ Exhibit A (2/7/02 letter from Cronin to Slater); Cronin Declaration, page 1, paragraph 3, lines 3-4; Exhibit C (2/7/02 letter from Cronin to Smith). Apparently, both worked at the same address.

⁷ 37 CFR 1.175(a)(2).

⁸ Paragraph 1.

⁹ Paragraph 4.

¹⁰ Paragraph 5.

versions of inventions (that claimed in the '708 Patent vis-à-vis that claimed in the instant reissue application) and conclude that the differences ("errors") arose without deceptive intention.

In view of the above, it is inappropriate and inaccurate for Bales to state, on behalf of Slater and Smith, that all errors being corrected in the present reissue application up to the time of the filing of the 2/14/03 Declaration arose without any deceptive intention. The 2/14/03 Declaration is thus not accepted, rendering this petition subject to dismissal.

A renewed §1.47(a) petition must:¹¹

- be filed within TWO MONTHS of the mailing date of this decision;¹²
- show that:¹³

- a *bona fide* attempt has been made to present to each of Slater and Smith copies of:
 - the '708 Patent (specification including claims; drawings);
 - any further amendments since February 14, 2003;
- Slater and Smith refuse to join in the reissue application;

and should be addressed as follows:

-by mail/by hand: Commissioner of Patents, USPTO
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

-by fax: (703) 308-6916
Attn: Office of Petitions

The Office acknowledges receipt with the petition of the \$130 petition fee and the \$130 surcharge for lacking an acceptable oath/declaration upon filing of the application.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



RC Tang
Petitions Attorney
Office of Petitions

¹¹ The renewed petition should supplement, and not re-iterate, information/argument already provided in the instant petition.

¹² 37 CFR 1.181(f).

¹³ The supplemental statement-of-facts must be signed by person(s) with first hand knowledge of the facts recited therein. See supra note 5.